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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,322	11/27/2001	Michael L. Gough	-	3459

7590 08/25/2004  
PERKINS COIE LLP  
101 Jefferson Drive  
Menlo Park, CA 94025-1114

EXAMINER

PHAM, KHANH B

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/997,322	<b>Applicant(s)</b> GOUGH ET AL.	
	<b>Examiner</b> Khanh B. Pham	<b>Art Unit</b> 2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 33-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 33-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/13/02, 1/27/03, 6/16/03, 11/10/03, 2/12/04</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Preliminary Amendment***

1. The preliminary amendment filed September 13, 2002 has been entered.
  - The title and Specification have been amended.
  - Claim 1 has been amended.
  - Claims 2-32 have been canceled.
  - Claims 33-51 have been added.
  - Claims 1, 33-51 are pending in this Office Action.

### ***Information Disclosure Statement***

2. The information disclosure statements (IDS) submitted on 9/13/2002, 1/27/2003, 6/16/2003, 11/10/2003 and 2/12/2004 have been considered by the examiner.

### ***Claim Objections***

3. Claims **40-51** are objected to because of the following informalities:  
duplicated word "**said**" at line 6 of claim 40 and line 5 of claim 46 should be deleted. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. **Claim 37** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 37 recites the limitation "**said video**" in line 1. There is insufficient antecedent basis for this limitation in the claim. For purpose of examination and compact prosecution, the Examiner presumes "said video" should read: "said audiovisual enhancement" and treats this limitation as "said audiovisual enhancement" in this Office Action.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1, 33-51 are rejected under 35 U.S.C. 102(e)** as being anticipated by Budge et al. (US 6,014,689 A), hereinafter "Budge".

**As per claim 1**, Budge teaches a method for providing an audiovisual e-mail system (Col. 1 lines 34-52) comprising:

- "providing a server connected to a network" at Col. 1 lines 18-23;

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(Budge teaches an e-mail sever connected to the Internet)

- “inputting a message and an audiovisual enhancement which is associated with said message from a sender into said server, said message to be sent as an e-mail to at least one recipient on said network” at Col. 1 lines 53-64;

(Budge teaches the step of associating video and audio data (i.e., “audiovisual enhancement”) to a video e-mail message)

- “associating said message with a self-executing programmable enhancement operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message” at Col. 2 lines 2-10 and Col. 8 lines 10-25;

(Budge teaches a self-executable video e-mail player attached to the e-mail message, the player decodes input bitstream and displaying video and audio data in the e-mail message)

- “and sending said e-mail over said network to said at least one recipient” at Col. 2 lines 25-27.

**As per claim 33**, Budge teaches a method as recited in claim 1 wherein “said audiovisual enhancement includes both audio and visual components” at Col. 1 lines 39.

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**As per claim 34**, Budge teaches a method as recited in claim 1 wherein "said audiovisual enhancement includes only an audio component" at Col. 2 lines 10-11.

**As per claim 35**, Budge teaches a method as recited in claim 1 wherein "said audiovisual enhancement includes only a visual component" at Col. 2 lines 10-11.

**As per claim 36**, Budge teaches a method as recited in claim 1, wherein "said audiovisual enhancement includes a streaming video displayed within a window of a recipient's machine" at Col. 5 lines 4-17.

**As per claim 37**, Budge teaches a method as recited in claim 1 wherein "said audiovisual enhancement is developed on a sender's machine, and is transmitted to said server over said network" at Col. 1 lines 36-44.

**As per claim 38**, Budge teaches a method as recited in claim 37 wherein "said network includes a TCP/IP network" at Col. 1 lines 20-21.

(Budge teaches the network includes the Internet, which is the network that uses TCP/IP protocol)

**As per claim 39**, Budge teaches a method as recited in claim 38 wherein "said network includes the Internet" at Col. 1 lines 20-21.

**As per claim 40**, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system comprising:

- "a code segment transmitting over a network to a server an audiovisual enhancement which is associated with a message from a sender, said

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message to be sent as an e-mail to at least one recipient on said network”

at Col. 1 lines 53-64;

- “a code segment associating said message with a self-executing code segment operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message upon the selection of said message by said at least one recipient” at Col. 2 lines 2-10 and Col. 8 lines 10-25.

**As per claim 41**, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein “said audiovisual enhancement includes both audio and visual components” at Col. 1 lines 39.

**As per claim 42**, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein “said audiovisual enhancement includes only an audio component” at Col. 2 lines 10-11.

**As per claim 43**, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein “said audiovisual enhancement includes only a visual component” at Col. 2 lines 10-11.

**As per claim 44**, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in

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claim 40 wherein "said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine" at Col. 5 lines 4-17.

**As per claim 45**, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein "said audiovisual enhancement is developed on a sender's machine" at Col. 1 lines 36-44.

**As per claim 46**, Budge teaches an audiovisual e-mail system comprising:

- "means transmitting over a network to a server from a sender machine an audiovisual enhancement which is associated with a message from said sender", said message to be sent as an e-mail to at least one recipient on said network" at Col. 1 lines 53-64; and
- "means associating said message with a self-executing program operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message on a recipient machine upon the selection of said message by said at least one recipient" at Col. 2 lines 2-10 and Col. 8 lines 10-25.

**As per claim 47**, Budge teaches an audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes both audio and visual components" at Col. 1 lines 25-27.

**As per claim 48**, Budge teaches an audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes only an audio component" at Col. 2 lines 10-11.

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**As per claim 49**, Budge teaches an audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes only a visual component" at Col. 2 lines 10-11.

**As per claim 50**, Budge teaches the audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine" at Col. 5 lines 4-17.

**As per claim 51**, Budge teaches the audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement is developed on said sender's machine" at Col. 1 lines 36-44.

### ***Conclusion***

9. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is **(703) 305-9601** for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (703) 308-7299. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The

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fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Khanh B. Pham  
Examiner  
Art Unit 2177

August 18, 2004

A handwritten signature in cursive script, reading "Khanh B. Pham", with a horizontal line underneath.